

REMARKS

The specification was amended at pages 2 and 27 to correct obvious typographic mistakes.¹ No new matter was added by these corrections.

Claims 1, 2, 11-13, 16, and 17 remain pending. Claims 14 and 15 were canceled, and their matter was added to claim 1. No new matter has been added.

In the final action, now-canceled claims 14 and 15 were rejected as obvious over Burns et al. WO 00/44847. This rejection is pertinent since the limitations of these rejected claims now appear in claim 1 and distinguish it and the remaining claims over the art of record. Claim 1 now requires one or more non-incorporable catalysts in a weight ratio of the catalysts to the at least one aminopolyether polyol of 20:1 to 1:3.

The rejection states, "[i]f the aminopolyether polyol is intended to be part of 'the catalyst' of claim 15, the aminopolyether polyol of the reference plus the exemplified amounts of DMDEE (e.g. page 20 [sic, 11], lines 25-27) fall within the scope of the instant claim 15." But the aminopolyether polyol may not be added to DMDEE in this way because the catalyst as claimed clearly excludes the aminopolyether polyols from its scope. While a rejection may rely on a broad, reasonable claim interpretation, this

¹ Refers to the translation of the international priority application WO 03/016368 filed September 30, 2004 in the present application.

rejection is manifestly unreasonable by opposing the plain meaning of applicants' words.

Applicants consistently define and use "catalyst" as exclusive of aminopolyether polyols or other isocyanate-reactive materials. After introducing and describing the polyisocyanate element for fourteen pages, the disclosure transitions to the next element of the claims: "[b]esides at least one polyisocyanate prepolymer, a one-pack polyurethane adhesive according to the invention preferably contains at least one non-incorporable catalyst. Suitable catalysts are, for example, tertiary amines which are not incorporated in the prepolymer chain" Spec., page 18, lines 8-11 (emphasis added). Numerous catalysts are listed, including DMDEE, none of which is reactive to the polyisocyanate prepolymers. Spec., page 18, line 10 to page 19, line 14. Thus the "catalyst" here disclosed and later claimed refers to a catalyst that is not reactive with isocyanates.

The description goes on to the next element of the invention:

Besides one or more polyisocyanate prepolymers and preferably one or more catalysts, a one-pack PUR adhesive according to the invention must also contain at least one aminopolyether polyol containing 2 to 4, preferably 3, OH groups where the molar ratio of ether groups to aminonitrogen atoms is ca. 7 to ca. 30, more particularly ca. 9 to ca. 25 or ca. 11 to ca. 20.

. . .
The term "contain" in relation to the aminopolyether polyol may be interpreted to mean that the aminopolyether polyol or a mixture of

two or more suitable aminopolyether polyols is bound into the polymer chain of the polyisocyanate prepolymer.

Page 19, lines 15-27. The aminopolyether polyol is introduced as a new, separate element. Further, because polyols bind to polyisocyanates, the aminopolyether polyol here described and later claimed cannot be a "non-incorporable catalyst" as that term is used in the preceding description. This exclusion is emphasized in the recitation of a "non-incorporable catalyst" in claim 1 as amended herein. Thus it is clear that the aminopolyether polyol should not be added to the catalyst.

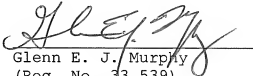
Calculated in a manner consistent with applicants' disclosure and claims, the ratio of catalyst to aminopolyether polyol found in Burns et al. WO 00/44847 is 1:20 to 1:1000. See Burns et al., page 5, lines 22-25 (aminopolyether polyol of 1% to 50% by weight) and page 11, line 27 (0.05 pph DMDEE). In general, Burns et al. describes a far smaller portion of non-incorporable catalyst relative to aminopolyether polyol than applicants claim. 1:20 to 1:1000 neither teaches nor is suggestive of 20:1 to 1:3. For this reason the claims are not obvious over Burns et al.

CONCLUSION

In view of the amendments and remarks above, Applicants ask for reconsideration and allowance of all pending claims. Should any fees be due for entry and

consideration of this Amendment that have not been accounted for, the Commissioner is authorized to charge them to Deposit Account No. 12-2135.

Respectfully submitted,


Glenn E. J. Murphy
(Reg. No. 33,539)
Attorney for Applicants
610-278-4926

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Henkel of America, Inc.
Patent Law Department
2200 Renaissance Blvd., Suite 200
Gulph Mills, PA 19406